

reconsideration of the rejections over the Jaskie patent in view of the following comments and the enclosed Declaration by Professor Singh.

Assertions in a prior art reference do not support an anticipation or obviousness rejection unless the reference places the claimed invention in the hands of the public. Beckman Instruments Inc. v. LKB Produkter AB, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). "In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." Id. While a reference is prior art for all that it teaches, references along with the knowledge of a person of ordinary skill in the art must be enabling to place the invention in the hands of the public. In re Paulsen, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). See also In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985).

The Jaskie patent speculates that a form of "wet filtration" can be used to separate and to prepare particles within a very narrow range of particle sizes. In an Amendment dated September 13, 1999, Applicants presented a detailed analysis of the wet filtration approach presented in the Jaskie patent. Applicants argued that the suggestions for wet filtration in the Jaskie patent at best would require an undue amount of experimentation and did not provide a reasonable expectation of success. In response to these arguments, the Examiner noted that there is a substantial presumption of validity of issued patents. Thus, allegations of invalidity without substantive evidence is insufficient to defeat the presumption of validity. The Examiner further noted that attorney statements should be supported by appropriate affidavit or declaration. A Declaration by Professor Singh is enclosed that supports Applicants' assertions regarding the shortcomings of the disclosure in the Jaskie patent.

In view of Dr. Singh's Declaration as support for Applicants' previous arguments, Applicants' believe that they have overcome

obviousness arguments based on the Jaskie patent. Applicants respectfully request withdrawal of the rejection of claims 1, 4-6, 20-25 and 27-30 under 35 U.S.C. §103(a) as being unpatentable over the Jaskie patent.

Rejections Over Jaskie in view of Bhargava

The Examiner rejected claims 2, 3 and 26 under 35 U.S.C. §103(a) as being unpatentable over the Jaskie patent in view of U.S. Patent 5,455,489 to Bhargava (the Bhargava patent). The Examiner cited the Bhargava patent for disclosing ZnO, ZnS and Y₂O₃ as phosphors. The Examiner further cited the Bhargava patent for disclosing the use of phosphors in an electroluminescent display. Applicants respectfully request reconsideration of the rejections based on the following comments.

As described in detail above, the Jaskie patent is deficient with respect to disclosing Applicants' claimed invention based on a narrow particle size distribution. The Bhargava patent does not teach or suggest the selection of particle size as a way of tuning the emission frequencies of phosphor particles. Furthermore, the Bhargava patent does not teach or suggest phosphor particles with a narrow size distribution as disclosed and claimed by Applicants. Thus, the Bhargava patent does not make up for the deficiencies of the Jaskie patent.

Since the Jaskie patent and the Bhargava patent do not teach appropriate approaches to produce phosphor particles with the narrow particle size distribution disclosed and claimed by Applicants, the combined disclosures of the two patents do not render Applicants' claimed invention obvious. Applicants respectfully request the withdrawal of the rejection of claims 2, 3 and 26 under 35 U.S.C. §103(a) as being unpatentable over the Jaskie patent in view of the Bhargava patent.

CONCLUSIONS

In view of the above amendments and remarks, Applicants submit that this application is in condition for allowance, and such action is respectfully requested. The Examiner is invited to telephone the undersigned attorney to discuss any questions or comments that the Examiner may have.

The Commissioner is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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